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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,880	04/09/2004	Adrianus Cornelis Kruik	88265-7114	9267

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EXAMINER	
TRAN LIEN, THUY	

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/820,880	KRUIK ET AL.	
	Examiner	Art Unit	
	Lien T Tran	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In all relevant claims, the term " biscuit like" is indefinite because the meaning and scope of such language cannot be determined. It is not known what would be considered as biscuit-like; is it the taste, the texture, the composition, the look or what?

In claim 1: Lines 4-5 are vague and indefinite; the biscuit-like mass is the mixture of particles of baked biscuit and a fat. Thus, it is not clear what applicant mean by " comprising a mixture of particles of baked biscuit and a fat, with the biscuit-like mass"

In claim 6: Line 3 is vague and indefinite. The language of a Markush group cannot include " or". Also, what does applicant mean by " and in the case of cocoa, cereals, or milk"; it is not clear how this phrase is tied in with the rest of the claim. The term " the non-biscuit powder" is unclear because it is not known what the term is referring to.

Claim 7 is vague and indefinite because the form of the product claimed is unclear. It is not clear how the ice confectionery is associated with the mass.

In claims 9-10, it is suggested applicant be consistent with the terminology used; claim 7 recites " ice confectionery" not " ice confection".

In claim 17, the phrase " the liquid biscuit-like mass" is unclear because it is not known what it is referring to. Claim 16 does not recite that the mass is liquid.

Claim 18 has the same problem as claim 17.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werbin et al (3508926).

Werbin et al disclose a method of using baked goods containing gelatinized starch and product formed by such method. The method comprises the steps of reducing a food material to granular or powdered form, mixing the particles with shortening material admixed with at least one emulsifier and forming the mixture into a mass of agglomerated product. The shortening include natural or hydrogenated animal or vegetable oil or fat. The agglomerated mixture can be formed to pieces which are added to soft ice cream. (see col. 2 lines 40-45, examples 3 and 7)

Werbin et al do not specifically disclose biscuit, the properties as recited in claim 1, the amount of fat in claim 4, the property of the fat as in claim 5, the inclusion of other ingredients, the amount of overrun as in claims 9-10, the making of the confection as in

claims 11, 17, the inclusion of other material in the ice confection as in claims 12-14, the form of the confection as in claim 15, the mixing temperature as in claim 16 and the forms as in claims 18-19.

Werbin et al disclose baked goods and discuss biscuits, cookies in the back ground section. Thus, it would have been obvious to use biscuit , cookies because there are included in the baked good group. When baked biscuit particles or any other baked good particles are mixed with the fat, it is obvious the mixture will have the same property as in claim 1 because the same materials are used. It is also obvious the fat will have the solid fat content as in claim 5 because Werbin et al disclose the same fat as claimed. It would have been obvious to vary the fat content when desiring to alter the taste, texture, consistency of the mixture. It would also have been obvious to add other food ingredients to enhance the taste of the product; the selection of the type of ingredients and the amounts can vary depending on the taste and flavor desired. It would have been obvious to use any known method to make the frozen confection; both molding and extrusion are well known in the art. It would also have been obvious to have any varying percent of aeration depending on the texture desired for the product. It would have been obvious to include other inclusion to enhance the taste of the ice confection; this is notoriously well known in the art. It would have been obvious to form the ice confection in forms such as bar, cup, stick, cone because all these form are common for ice confection product. It would have been within the skill of one in the art to determine the appropriate temperature of the fat so that it can be easily mixed with the particles. This can readily be determined through routine experimentation. It would

have been obvious to form the ice confection as the shell or the biscuit particles as the shell depending on the type of confection wanted. If more ice confection is wanted and the particles are intended as small amount of inclusion, it would have been obvious to form a shell of confection and then filling the shell with the particles. It would also have been obvious to do the reverse because it is well known in the art to use cookie crumb to make shell for various type of filling. For example, it is well known to use cookie crumb to make crust and to use the crust in making mud pie with different types of ice cream. The concept of removing portion of a molded product to create an open cavity is well known in the art. Bread is made into soup bowl by removing portion of the bread dough, melon is made into bowl by scooping out the inside fruit, cake bowl is made by removing a portion of the cake to create cavity for fruit filling etc.. It would have been obvious to one skilled in the to create such cavity when one wants to make product containing open cavity filled with ice cream. Ice confections come in many different shapes and forms; one can readily see this in a supermarket or ice cream novelty store. It would have been obvious to one skilled in the art to make the various forms claimed because they are well known in the art. It would have been within the skill of one in the art to determine the temperature to pour the particles through routine experimentation in absence of showing of unexpected result or criticality.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10,13 and 17 of copending Application No.10/761614. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are directed to composite product comprising biscuit product and ice confection. The product of the co-pending application does not contain additional non-biscuit particles as cited in claim 6, the property as cited in claim 5, the presence of the biscuit as coating, core or inclusion, the type of confection, the inclusion of particles in the ice confection, the way the confection is made and the forms of the ice confection as in claims 8-15. This difference is not patentably significant because it would have been obvious to add other ingredients to the biscuit particles to obtain different texture, flavor and taste. It would have been obvious to use any type of ice confection with the biscuit depending on the taste desired. It would have been obvious to use the biscuit as core, inclusion or coating depending on the type of frozen composite product and the taste wanted. It would have been obvious to add other inclusions such as nut, chocolate chip, fruit etc.. to obtain different taste and flavor. This is notoriously well known in the art. It would have been obvious to use any known method to make the ice confection and extrusion is a well known method for such purpose. It would have been obvious to

vary the percent of overrun depending on the amount of aeration and the texture wanted. It would have been obvious to form the frozen confection in the forms of sandwich, cup, cone, bar because all these forms are well known in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Van Lengerich disclose using cookie crumb to form an edible matrix.

Laffont et al disclose frozen dessert having a layer of biscuit.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien T Tran whose telephone number is 571-272-1408. The examiner can normally be reached on Wed-Fri.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 2, 2005

LTran

LIEN TRAN
PRIMARY EXAMINER
Group 1700